



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,869	04/17/2006	Rami Salib	09669/080001	5093

22511 7590 07/26/2007
OSHA LIANG L.L.P.
1221 MCKINNEY STREET
SUITE 2800
HOUSTON, TX 77010

EXAMINER

VO, TUYEN KIM

ART UNIT	PAPER NUMBER
----------	--------------

2876

MAIL DATE	DELIVERY MODE
-----------	---------------

07/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/564,869

Applicant(s)

SALIB ET AL.

Examiner

Tuyen Kim Vo

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/17/2006</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Information Disclosure Statement

1. References listed in the information disclosure statement (IDS) submitted on 04/17/2006 have been considered by the examiner. See attached PTO-1449 or PTO/SB/08A and 08B forms.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 2876

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art (background of art disclosure on pages 1-2) in view of McCabe et al. (McCabe) (US 6,068,192).

Re claims 1 and 7, the admitted prior art teaches a chip card comprises a card body and a chip module, which is embedded in the card body and incorporates an integrated circuit (IC). The embedded IC, so called "security features" are present on the surface of the card body. However, the admitted prior art fails to teach an additional tamper-detection layer including a conductive pattern forming an electrical loop connected between terminals of IC.

McCabe, from the same field of endeavor, teaches a smart card having tamper detection layer having conductive pattern connecting between the terminal of IC to prevent tampering. See abstract and column 5, lines 17-37.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the smart/IC card of the admitted prior art by incorporating the tamper-detection layer as taught by McCabe so as to protect the smart/IC card from tampering. See column 5, lines 35-37 of McCabe.

Re claim 3, McCabe further teaches the smart card including contactless communication features and the conductive pattern is part of a tuned circuit cooperating with the IC for contactless communication. See column 7, lines 7-18.

Art Unit: 2876

Re claim 4, the admitted prior art teaches the smart card includes at least one security features from the group of including photograph, hologram, multiple laser image, laser engraving, UV/IR-readable pattern and magnetic-readable encoding. See page 1, lines 1-24 of the disclosure. In addition, McCabe further teaches the smart card including one security feature, which is magnetic stripe. See column 5, lines 46-52.

Re claim 5, McCabe further teaches the conductive pattern is made from a conductive ink material. See column 7, line 61 to column 8, line 16.

Re claim 6, McCabe further teaches the conductive pattern is made from a transparent or near transparent material. See column 7, lines 38-39 and column 8, lines 18-22.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 2876

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of McCabe et al. (McCabe) (US 6,068,192) as applied to claim 1 above, and further in view of Irwin et al. (Irwin) (US 6,491,215 B1).

Re claim 2, both the admitted prior art and McCabe teach all subject matter claimed above (see section 5) except for the conductive pattern has a given impedance or resistance and the IC is adapted to check the impedance or resistance matches a predetermined value stored in a memory of the IC.

Irwin teaches a conductive patter (conductive bar 100) has a given resistance (such as resistor track 82-96. See column 11, lines 6-35) and the IC (electronic circuit 81) is adapted to check the resistance matches a predetermined value stored in a memory (see column 3, lines 13-24). See column 8, line 46 to column 9, line 9.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the chip card of the admitted prior art in modify of McCabe by providing the conductive pattern which has a given resistance value as taught by Irwin so as to detect the chip card from tampering, alteration and counterfeiting.


Art Unit: 2876

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuyen Kim Vo whose telephone number is 571-270-1657. The examiner can normally be reached on Monday - Friday, 7:30a.m. - 5:00p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Tuyen Kim Vo
Patent Examiner
Art Unit 2876
July 23, 2007.


THIEN M. LE
PRIMARY EXAMINER